UNITED STATES PATENT AND TRADEMARK OFFICE

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10/796,181	03/10/2004	Kenji Tani	1560-0411P	3272

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER
SARPONG, AKWASI

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/796,181	TANI ET AL.
	Examiner	Art Unit	
	AKWASI M. SARPONG	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>03 December 2008</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-92</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-92</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>10 March 2004</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some * c) ☐ None of:

        1. ☒ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>03/10/2004, 12/12/2005 , 09/05/2008 and 09/05/2008</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

12/03/2003 has been entered.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

2.   Claims 1-8, 13-70, 75-92 are rejected under 35 U.S.C. 102(e) as being

anticipated by Hirano (2003/0105950).

        Claim 1-4, Hirano discloses an image processing method which uses an image

processing apparatus **(Section 0129, apparatus 100 shown in Fig. 1)** for receiving

color image data so as to store the data into a storage section **(Section 0114,**

electronic documents are stored into database 109 and 110) and then performing-

the output processing of the color image data stored in said storage section, **(Section**

0114, - thus the electronic document is retrieved to be further processed) said

method comprising the steps of:

authenticating a requestor of the output processing of the received color image

data **(Section 0489, thus authentication process takes place within computer 950)**

NB: Understand that Computer 950 is an example of Apparatus 100.

extracting a specific color portion of the received color image data, when the

authentication is not completed deleting the extracted specific color portion from the

received color image data, **(Section 0489, thus if the user's authentication is not**

complete then the secret information (Specific color portion) is concealed)

(NB: Understand that the secret information portion has to be extracted

before it can be deleted or concealed and it is inherent that, in printing, the image

data/secret information will be represented by the color (e.g., C or Y or M or K)

that is to be deposited onto a print medium; by extracting the secret information

must also at the same time extracting the color ink information that is to be

printed onto the print medium or other wise, the color ink will be printed if not

extracted) wherein

the specific color portion is output to be visible for the requestor, when the

authentication is completed. **(Section 0494 lines 4-7 thus in the authentication is**

complete then the whole image data is outputted or displayed).

Claim 5-8, Hirano discloses an image processing method which uses an image

processing apparatus **(Section 0129, apparatus 100 shown in Fig. 1)** for receiving

color image data so as to store the data into a storage section **(Section 0114,**

electronic documents are stored into database 109 and 110) and then performing-

the output processing of the color image data stored in said storage section **(Section 0114, - thus the electronic document is retrieved to be further processed)** <u>or</u> alternatively the output processing with the exclusion of a specific color, said method comprising the steps of:

acquiring specific color information concerning the specific color of the received color image data; **(Section 0486, thus the categories and keywords are information used to look for the image data stored in the database, hence if the image have some color then the information will also have some color information)**

authenticating- a requestor of the output processing of the color image data the specific color information of which is acquired **(Section 0489, thus authentication process takes place within computer 950).**

extracting a specific color portion of the received color image data; and deleting the extracted specific color portion from the received color image data, when the authentication is failed **(Section 0489, thus if the user's authentication is not complete then the secret information (Specific color portion) is concealed)**

(NB: Understand that the secret information portion has to be extracted before it can be deleted or concealed and it is inherent that, in printing, the image data/secret information will be represented by the color (e.g., C or Y or M or K) that is to be deposited onto a print medium; by extracting the secret information must also at the same time extracting the color ink information that is to be printed onto the print medium or other wise, the color ink will be printed if not extracted) wherein the specific color portion is output to be visible for the requestor,

when the authentication is completed. (**Section 0494 lines 4-7 thus in the authentication is complete then the whole image data is outputted or displayed).**

Claim 13-16, Hirano discloses wherein the image processing apparatus further comprising a deleting section **(the portion of Computer 950 that deletes or conceals the secret information when the authentication fails- see Section 0489)** for deleting the specific color portion which is stored in said storage section and the output processing of which is completed, once the output processing is completed. **(Section 0489- thus the secret information in document or image 901 is deleted or concealed if the authentication fails)**

Claim 17-20, Hirano discloses wherein the image processing apparatus further an encrypting section **(Fig. 1 Section 104)** for encrypting the specific color portion to be stored into said storage section. **(Section 0113- thus the encryption section encrypts image)**

Claim 21-28, Hirano discloses wherein the image processing apparatus further comprising a specific color reception section for receiving the specification of a specific color. **(the data input unit 101 shown in fig. 1 is used to input image data into the system or be stored into the database).**

Claim 29-32 Hirano discloses wherein the image processing wherein importance levels are set for said specific colors. **(Section 0493, lines 1-5, thus as the secret information is been embedded into document 901, the secret information is set as an importance level than the other parts of the document)**

NB: Understand that the secret information is set as an importance level since it

is been protected from unauthorized users- Please see Section 0495.

Claims 33-37, Hirano discloses wherein said specific color portion is a character

portion in a specific color. **(Section 0494- the secret information is a character as it**

is displayed on a character display portion also see Section 0114 and database

109)

Claims 38-40, Hirano discloses wherein said specific color portion is a graphic

portion containing a specific color. **(Fig. 2 El. 209 shown a portion of the database**

in the server which is assign to storing only image portion).

Claims 41-44, Hirano discloses wherein said output stopping section replaces

the specific color portion with a predetermined mark. **(Section 0489- thus the**

"asterisks" is a predetermined mark used as an indication of the image portion

that has been deleted as shown in Fig. 73).

Claim 45-48, Hirano discloses an image processing apparatus that further

comprising a notifying section for notifying the output stop of the specific color portion,

when the output of the specific color portion is stopped. **(Section 0489 portion of the**

authentication section that replace the secret information with the characters

"astericks" because that is the indication that authentication was incomplete and therefore it has stopped).

Claim 49-50, Hirano discloses an image processing apparatus **(Section 0129, apparatus 100 shown in Fig. 1)** for receiving color image data so as to store the data into a storage section **(Section 0114, electronic documents are stored into database 109 and 110)** and then performing output processing including the transmission of the color image data stored in said storage section, **(Section 0114, - thus the electronic document is retrieved to be further processed)** said apparatus comprising:

a destination storing section for storing a destination to which the transmission of a specific color portion of the received color image data is allowed; **(Section 0312- thus for terminal 800 to transmit electronic document to a second user terminal 820, the first terminal at least have to know the IP address of the second terminal and therefore have the IP address stored in the database)**

an extracting section for extracting the specific color portion of the received color image data when the destination of the received color image data is not stored in said destination storing section and **(Section 0489, thus if the user's computer information is not available then there will not be any a destination for transmission and therefore authentication will not be complete then the secret information (Specific color portion) is concealed)**

(NB: Understand that the secret information portion has to be extracted before it can be deleted or concealed and it is inherent that, in printing, the image

data/secret information will be represented by the color (e.g., C or Y or M or K)

that is to be deposited onto a print medium; by extracting the secret information

must also at the same time extracting the color ink information that is to be

printed onto the print medium or other wise, the color ink will be printed if not

extracted) an output stopping section for deleting the extracted specific color portion

from the received color image data, wherein the specific color portion is output to be

visible, when the destination to which the transmission of the specific color portion of the

received color image data is allowed is stored in the destination storing section.

(Section 0494 lines 4-7 thus when the authentication is complete then the whole

image data is outputted or displayed).

Claim 51-56, Hirano discloses an image processing apparatus wherein said

output processing includes the transmission of the image data, and wherein

said apparatus further comprises an encrypting section **(Fig. 1 Section 104)** for

encrypting the specific color portion of the image data to be transmitted. **(Section 0113-**

thus the encryption section encrypts image).

Claim 57-62, Hirano discloses an image processing apparatus that further

comprising a transmitting section **(Transmitting side of terminal 820 which is the**

same as the user side shown in Fig. 70 or apparatus 100 in Fig. 1) for transmitting

specific color information concerning the specific color. **(Section 0314-paper**

document 823)

Claim 63-66, Hirano discloses an image processing apparatus **(Section 0129,**

apparatus 100 shown in Fig. 1) for receiving color image data so as to store the data

into a storage section **(Section 0114, electronic documents are stored into database**

109 and 110) and then performing output processing including the transmission of the

color image data stored in said storage section **(Section 0114, - thus the electronic**

document is retrieved to be further processed) or alternatively the transmission with

the exclusion of a specific color, said apparatus comprising:

an acquiring section for acquiring specific color information concerning the

specific color of the received color image data; **(Section 0486, thus the categories**

and keywords are information used to look for the image data stored in the

database, hence if the image have some color then the information will also have

some color information)

a destination storing section for storing a destination to which the transmission of

the specific color portion of the received color image data is allowed **(Section 0312-**

thus for terminal 800 to transmit electronic document to a second user terminal

820, the first terminal at least have to know the IP address of the second terminal

and therefore have the IP address stored in the database)

a determining section **(Section 0489, the authentication portion that makes**

the judgment whether the password and username provided by the user is valid)

for determining whether the destination of the specific color portion of the received color

image data the specific color information of which is acquired by said acquiring section

is stored in said destination storing section or not; **(Section 0489- thus if the**

destination is found then authentication is complete if it is not found then

authentication is incomplete) an extracting section **(Section 0482, the portion of**

server 900 that extract image data 904 from document 901) for extracting the

specific color portion of the received color image data; and an output stopping section

(Section 0489- thus the portion of Computer 950 that conceal or deletes the secret

information from the document 901 when authentication fails) for deleting the

extracted specific color portion when said determining section determines that the

destination of the specific color portion of the received color image data is not stored in-

said the destination storing section, **(Section 0489, thus if the user's computer**

information is not available then there will not be any a destination for

transmission and therefore authentication will not be complete then the secret

information (Specific color portion) is concealed or deleted)

      (NB: Understand that the secret information portion has to be extracted

before it can be deleted or concealed and it is inherent that, in printing, the image

data/secret information will be represented by the color (e.g., C or Y or M or K)

that is to be deposited onto a print medium; by extracting the secret information

must also at the same time extracting the color ink information that is to be

printed onto the print medium or other wise, the color ink will be printed if not

extracted) <u>wherein</u> the specific color portion is output to be visible, when the

determining section determines that the destination of the specific color portion of the

received color image data is stored in the destination storing section. **(Section 0494 lines 4-7 thus when the authentication is complete then the whole image data is outputted or displayed).**

Claim 67-70, Hirano discloses wherein said specific color information is added to the received image data, while said acquiring section acquires the specific color information added to the received image data. **(Section 0486, thus the categories and keywords are information used to look for the image data stored in the database, hence if the image have some color then the information will also have some color information).**

Claims 75-78, Hirano discloses wherein the image processing wherein importance levels are set for said specific colors. **(Section 0493, lines 1-5, thus as the secret information is been embedded into document 901, the secret information is set as an importance level than the other parts of the document)**

NB: Understand that the secret information is set as an importance level since it is been protected from unauthorized users- Please see Section 0495.

Claim 79-84, Hirano discloses an information processing apparatus **(Section 0129, apparatus 100 shown in Fig. 1)** for transmitting image data to the image processing apparatus **(a document is transmitted from the first user terminal to the second user terminal-see Section 0312)** wherein said information processing apparatus comprising:

a reception section **(Section 0312- the portion of the second user terminal**

that receives the transmitted document) for receiving specific color information

concerning a specific color **(Section 0488- understand that image data 904**

inherently will have a color in it) and a converting section **(Image analyzing section**

1002 shown in Fig. 74) for converting into said specific color a predetermined color in

the image data to be transmitted to said image processing apparatus. **(Section 0502-**

thus image data 901 before it will be printed will have to processed to get the

colors within the pictures, understand that inherently the picture will be made of

at least a black color)

Claim 85-88, Hirano discloses an information processing apparatus **(Section**

0129, apparatus 100 shown in Fig. 1)   for transmitting image data to the image

processing apparatus **(a document is transmitted from the first user terminal to the**

second user terminal-see Section 0312)   wherein said information processing

apparatus comprising:

a reception section **(Section 0312- the portion of the second user terminal**

that receives the transmitted document) for receiving specific color information

concerning a specific color of the image data to be transmitted, **(Section 0488-**

understand that image data 904 inherently will have a color in it and also

contains XML 902, XSL 903 and data image 904)

and wherein said information processing apparatus transmits the image data and

the specific color information received by said reception section. **(Section 0486, if the**

whole document 901 is transmitted then it will include XML 902, XSL 903 and data

image 904 as clearly shown in Fig. 70)

Claim 89-92, Hirano discloses information processing apparatus that further

comprising:

an adding section **(the portion of server 900 that embeds secret information**

into document 901) for adding the specific color information received by said reception

section to the image data to be transmitted, **(Section 0491, thus the secret**

information is embedded or integrated into document 901) wherein said

information processing apparatus transmits the image data to which the specific color

information is added by said adding section. **(Section 0493, thus secret information is**

embedded into the document 901 by server 900 and then document 901 together

with embedded secret information is transmitted to computer 950)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Hirano (2003/0105950) in view of Li (20040119726)

Claim 9-12, Hirano does not discloses wherein said storage section comprises: a semiconductor storage device for storing the specific color portion of the received image data; and a magnetic storage device for storing a non-specific color portion other than the specific color portion of the received image data.

Li discloses an image processing apparatus **(Section 0053, lines 1-2, Printer 102 shown in Fig. 1A)** wherein said storage section **(Section 0054, line 3, Computer storage media)** comprises: a semiconductor storage device for storing the specific color portion of the received image data **(Section 0054, lines 5-9, RAM and ROM shown in Fig. 1B)** and a magnetic storage device for storing a non-specific color portion other than the specific color portion of the received image data. **(Section 0054, lines 10-16, Magnet disc such as hard disk or a floppy disk can also be used to store specific information).** Therefore it will be obvious to one ordinary skilled in the art at the time the invention was made to modify Hirano's database 1035 to be replaced by Li's storage media so that the computer 950 will have the both semiconductor and Magnetic storage medium. This will enable users to have control over their documents that matter to them.

Claim 71-74, Hirano does not discloses wherein a plurality of colors is used as said specific color.

Li discloses wherein a plurality of colors is used as said specific color. **(Section 0055- color components such as Cyan, magenta, yellow are parts of the image**

stored that is going to be printed). Therefore it will be obvious to one ordinary skilled

in the art at the time the invention was made to modify Hirano's secret information (i.e

specific color) to include color components such as Cyan, magenta and yellow. The

motivation for doing this to give the document multiple colors and makes it beautiful.

Response to Arguments

4.   Applicant's arguments filed 12/03/2008 have been fully considered but they are

not persuasive.

         Regarding Claims 1 applicant argues that the cited reference fails to disclose or

teach the limitation "deleting the extracted specific color portion from the received color

image data"

         In reply, Examiner respectfully disagree because Hirano disclose in Section

0489 that the secret information portion is concealed or deleted if the user

authentication is not completed.

         Regarding Claim 1 again applicant argues that the cited reference fails to

disclose or teach the limitation "wherein the specific color portion is output to be visible

far the requester.

In reply, Examiner respectfully disagree because Hirano discloses in Sections

0490 and 0491 that if the user authentication is completed the secret information is

retrieved and added to document data and displayed to the user.

For the same limitations that are recited in independent claims 2-8, 49, 50 and

63-66, please refer to the above discussion.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to AKWASI M. SARPONG whose telephone number is

(571)270-3438. The examiner can normally be reached on Monday-Friday 8:00am-

5:00pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

AMS
04/06/2009